REMARKS

In response to the Office Action dated August 22, 2005, claims 1, 7, and 17 have been amended. Claims 1-23 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

Claims 1-3, 6-15, 17, and 19-23 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Miura et al. (U.S. Patent No. 6,862,103).

The Applicants respectfully traverse this rejection in light of the amendments to the claims and submit that the Miura et al. reference does not disclose all of the claimed features. For instance, although Miura et al. disclose using a form template, merging it with data by an image generation unit, converting the merged data into PDL data by a print output unit, and printing the converted data as a high-quality image for generating a personalized publication (see Abstract of Miura et al.), Miura et al. is missing elements of the newly amended claims.

Namely, Miura et al. does **not** disclose the Applicant's claimed personalized content for the document that is <u>retrieved from a content network resource</u> and <u>personalized to the interests</u> of a user <u>based on a profile of previously entered preferences of the user.</u> (see for example, at least paragraph [0015] of the Applicant's U.S. Publication No. 2003/0154325). Therefore, since Miura et al. does not disclose all of the elements of the Applicant's claimed invention, Miura et al. cannot anticipate the claims, and hence, the Applicant submits that the rejection 35 U.S.C. 102(e) under should be withdrawn.

The Office Action rejected claims 4, 5, 16, and 18 under 35 U.S.C. 103(a) as allegedly being unpatentable over Miura et al. in view of Gibson (U.S. Patent No. 5,761,684).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

Namely, the Applicant submits that the **combination** of Miura et al. and Gibson et al. do not disclose, teach, or suggest the Applicant's claimed accessing a <u>content network resource</u> and <u>locating personalized content of interest</u> to a user <u>based on a profile of previously entered preferences of the user.</u> In particular, as argued above, Miura et al. merely disclose converting merged data and generating a personalized publication while Gibson simply discloses scheduling script execution in a compound document (see
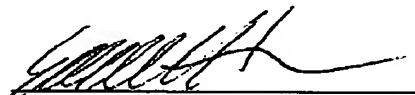
6

Abstract of Gibson). In contrast, unquestionably, the combined references do **not** disclose, teach, or suggest the Applicant's accessing a <u>content network resource</u> and <u>locating personalized content of interest</u> to a user <u>based on a profile of previously entered preferences of the user</u>. This **failure** of the cited references, in combination or alone, to <u>disclose, suggest or provide motivation</u> for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (*MPEP 2143*).

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly request the Examiner to telephone the Applicants' attorney at **(818) 885-1575** if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

                                            Respectfully submitted,
                                            Dated: November 22, 2005

                                            Edmond A. DeFrank
                                            Reg. No. 37,814
                                            Attorney for Applicants
                                            (818) 885-1575 TEL
                                            (818) 885-5750 FAX

7